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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/659,599 09/11/00 MCGALL G 3357

022886 HM22/0531  
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EXAMINER

EPPEPS, J

ART UNIT

PAPER NUMBER

1635

DATE MAILED:

05/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09/659,599	Applicant(s) MCGALL, GLENN H.	
	Examiner Janet L Epps	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### SUPPLEMENTAL ACTION

The rejection of claim 1 under 35 USC 102(b) and 35 USC 103(a) over Okamoto et al. set forth in the Official Action mailed 5-23-01 is withdrawn. The remaining grounds of rejection of claims 1-29 set forth in the Official Action mailed 5-23-01 are repeated here.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiyoto et al. The use of the transitional phrase "*consisting essentially*," recited in claim 1, and those claimed dependent thereon, is being considered equivalent to the term "*comprising*" since the specification as filed does not include a clear indication of what the basic and novel characteristics of the claimed compound actually are. Since, it is not clear whether an additional component in the prior art would materially affect the basic and novel characteristics of the claimed compound, the following prior art is applied. Moreover, since the specification as filed describes the compounds designated as "Y" as comprising substituents other than hydrogen in the aromatic ring, for prior art purposes the structures recited in claim 1 will be interpreted as Additionally, since the formula Y-C(O)- is ambiguous with regards to the attachment of the -C(O)- moiety to

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the Y compound, this formula will be interpreted as meaning a Y compound comprising a  $-C(O)-$  moiety.

Kiyoto et al. disclose a method for the preparation of 5-deoxy-5-ureido- $\beta$ -D-allofuranosyluronic acid pyrimidine derivatives. The compound  $\beta$ -D-allofuranuronic acid, 1,5-dideoxy-1-(3,4-dihydro-2,4-dioxo-1(2H)-pyrimidinyl)-5-[[[(2-nitrophenyl)amino]carbonyl]amino] (see compound 4, page 6; and compound 2(3) page 36) comprises the one of the compounds designated as "Y" recited in claim 1 of the instant application, wherein said compound is o-nitrophenylaminocarbonyl, and further wherein said compound comprises a nucleoside chemical fragment.

Kiyoto et al. teach each and every aspect of the instant invention thereby anticipating Applicant's claimed invention.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Catalanotti et al.

Catalanotti et al. disclose compounds comprising one of the compounds designated as "Y" recited in claim 1 of the instant application, wherein said compound is O-nitrophenylaminocarbonyl (see page 2236, compound **4c**).

Catalanotti et al. et al. teach each and every aspect of the instant invention thereby anticipating Applicant's claimed invention.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Bodanszky (US Patent 3944538).

Bodanszky discloses a process and apparatus for the synthesis of peptides. An example of an embodiment of the process of the invention is the following: A peptide protected at its N-terminal with t-butyloxy-carbonyl group is briefly treated with

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trifluoroacetic acid, this acid removed in vacuo, the residue treated with ether and the trifluoroacetate salt is isolated by filtration or centrifugation. To a solution of this salt in dimethylformamide, an equivalent amount of tertiary base, e.g., triethylamine or diisopropylethylamine, is added followed by the amino acid to be incorporated, in protected and activated form, such as t-butyloxycarbonyl amino acid o-nitrophenyl ester (col. 1-2 bridging paragraph). The t-butyloxycarbonyl amino acid o-nitrophenyl ester compound used in the process of Bodanszky comprises one of the structures designated as "Y" recited in claim 1 of the instant application, wherein said structure is N2POC.

Bodanszky teaches each and every aspect of the instant invention thereby anticipating Applicant's claimed invention.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pieles et al. or Neuner et al.

Both Pieles et al. and Neuner et al. teach the solid phase synthesis of oligonucleotides comprising the use of (+)biotin-2-nitrophenyl ester (Neuner et al. page 148, scheme 2 reagent ix; Pieles et al. Figure 1, reagent ii). The compounds of Pieles et al. and Neuner et al. comprise the N2POC structure recited in claim 1 of the instant application.

Pieles et al. and Neuner et al. teach each and every aspect of the instant invention thereby anticipating Applicant's claimed invention.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Wiley et al.

Wiley et al. disclose compounds comprising one of the compounds designated as "Y" recited in claim 1 of the instant application, wherein said compound is o-nitrophenylaminocarbonyl (see page 885, compounds 9-11).

Wiley et al. teach each and every aspect of the instant invention thereby anticipating Applicant's claimed invention.

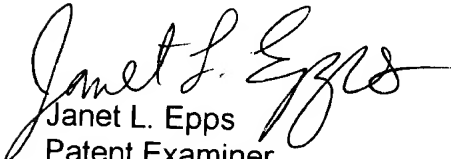
### ***Drawings***

8. The drawings filed 9-11-00 have been objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons set forth on the attached PTO-948.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L Epps whose telephone number is 703-308-8883. The examiner can normally be reached on Mondays through Friday, 9:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703)-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Janet L. Epps  
Patent Examiner  
May 29, 2001